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60130-1179
00MRA0557**REMARKS**

Reconsideration and allowance are respectfully requested. Claims 1-14 and 16-26 are currently pending and stand rejected. Applicant has amended claims 1, 5, 14, 16 and 21. No new matter has been added.

§ 112 rejection

Claims 21-26 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicant has amended independent claim 21 to obviate this rejection. Withdrawal of the rejection is therefore respectfully requested.

§ 102 rejections

Claims 1, 3, 9, and 12-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 684 356 ("EP '356"). Applicant respectfully traverses this rejection.

The Office Action asserted that EP '356 shows a resilient drive transfer device 19 that is inherently operably disconnectable from an output element 7 (p. 3). The Office Action further argued that "any two elements are inherently disconnectable from one another" and that the claim "broadly limits the transfer device to be disconnectable from the output element" (p. 5). Applicant respectfully traverses this rejection.

As noted in previous responses, the Federal Circuit has clearly stated that inherency cannot be established simply by asserting that a certain thing may result from a given set of circumstances. To support an inherency argument, the disclosure offered by the Examiner must be "sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function" and that the missing claimed element is "necessarily present" in the reference such that it would be recognized by persons of ordinary skill. Finnegan Corp. v. ITC, 51 USPQ2d 1001 (Fed. Cir. 1999), quoting In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Further, "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" MPEP § 2112. To rely upon an inherency theory, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

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characteristic necessarily flows from the teachings of the applied prior art" MPEP § 2112. The Office Action has failed to meet this burden.

The Office Action sets forth an improper inherency argument and has not indicated how the claimed invention naturally flows from the teachings of EP '356. Separate components are not operably disconnectable simply because they are separate, particularly when there is no reason ~~taught in the EP '356 to operably disconnect them. Nothing in EP '356 leads one of ordinary skill~~ in the art to believe that its separate parts are indeed operably disconnectable, particularly because EP '356 clearly indicates that all of the separate parts are interlocked together and are intended to operate interdependently (see, e.g., Figure 18).

Although the Office Action stated that the claim broadly covers a transfer device that is operably disconnectable from the output element, EP '356 does not fall within the claim language even under this broad interpretation. As noted in the previous response and as shown in Figures 16, 18, and 19, it is impossible for the cam 7 in EP '356 to operably disconnect from the elastic member 19 to allow the output element to move independently of the gear 5 between any output positions due to the interlocking fit between the cam 7 and the elastic member 19 and between the cam 7 and the gear 5.

As shown in Figure 19, the cam 7 is physically integrated with the elastic member 19, indicating that operable disconnection between the two is impossible (col. 14, lines 12-33). Due to this physical integration, movement of the cam 7 will always result in movement of the elastic member 19 and vice versa. Nothing in EP '356 would lead one of ordinary skill to think that the cam 7 can ever be operably disconnected from the elastic member 19, nor does EP '356 even hint that such an operable disconnection is possible. Thus, operable disconnection between the cam 7 and the elastic member 19 does not naturally flow from the teachings in EP '356.

Moreover, the cam 7 is never able to move between first and second output positions independently of the gear wheel 5. Every embodiment described in EP '356 assumes that rotation of the gear 5 will result in rotation of the cam 7 (see, e.g., col. 9, lines 24-34; col. 11, lines 11-23). More particularly, the interlocked relationship between the gear 5 and the cam 7 makes it impossible for the cam 7 to move independently of the gear 5, let alone between first and second output positions that correspond to first and second gear positions of the gear 5 during times

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when the gear 5 and the cam 7 are operably connected (see, e.g., Figure 15 and col. 12, lines 14-45).

Figures 4 through 8 of EP '356 only show transition positions between a first gear position (Figure 1) and a second gear position (Figure 9). The cam 7 and its associated lug 7A are unable to reach the output position shown in Figure 9 when the lug 7C associated with the gear 5 is in the position shown in Figure 1. Similarly, the cam 7 and its lug 7A are unable to reach the output position shown in Figure 1 when the lug 7C associated with the gear 5 is in the position shown in Figure 9. The cam 7 therefore is unable to move between first and second output positions independently of the gear 5.

Thus, due to the integration (and therefore the permanent operable connection) of the cam 7 and the elastic member 19, and due to the inability of the cam 7 to move independently of the gear 5 at all, EP '356 fails to disclose an actuator that allows an output element to move between first and second output positions independently of the gear wheel when the output element is operably disconnected from a drive transfer device. EP '356 therefore fails to disclose claims 1, 3, 9, and 12-20, and withdrawal of the rejection is respectfully requested.

Claims 14 and 16-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,697,237 to Dilger et al. ("Dilger"). Applicant respectfully traverses this rejection.

Applicant has amended independent claim 14 to clarify that the stop device conducts motor stoppage by preventing rotation of the motor. Dilger fails to disclose the invention because Dilger only focuses on interrupting a connection between a driver fork 19 and a turning lever 11 powered by a motor 18 and not stopping the motor 18 itself. As can be seen in Figures 1, 2 and 6, Dilger teaches moving spherical arresting elements 32 out of arresting openings 31 if the driver fork 19 is blocked (col. 4, lines 28-34). This severs the connection between the driver fork 19 and the turning lever 11, but the operation of the motor 18 itself is not interrupted.

As a result, the motor 18 continues to rotate, thereby rotating the gear wheel 21 and causing the device to continue cycling between a locked and an unlocked position, even after the driver fork 19 has been disconnected from the turning lever 11. Nothing in Dilger addresses controlling the operation of the motor itself with a stop device like the claimed invention. Dilger therefore does not anticipate claims 14 and 16-20, and withdrawal of the rejection is respectfully requested.

60130-1179
00MRA0557**§ 103 rejections**

Claims 1-7, 9, 10, 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dilger in view of EP '356. Applicant respectfully traverses this rejection.

The Office Action admitted that Dilger does not disclose an output member that is ~~rotatable about the same axis as a drive gear, but asserted that it would have been obvious to~~ modify Dilger in view of EP '356 to provide the drive gear and the output element on the same axis to provide a more compact drive train (pp. 3-4). Applicant respectfully disagrees.

There is no motivation to modify Dilger in the manner suggested by the Examiner. Dilger requires its drive gear 21 to rotate about a different axis than the output element 12 because there is no other way to move the arms 262, 263 out of the path of the driver pin 23. Similarly, the actuating lever 8 in EP '356 can turn into and out of the path of the cam 7 only because the actuating lever and the cam 7 rotate about different axes (see, e.g., Figure 14). If the drive gear 21 and the output element 12 in Dilger rotated about the same axis, it would be impossible to move the arms 262, 263 into and out of the path of the pin 23 because the pin 23 would be directly under the output element 12 rather than offset from it. Such a combination would make Dilger inoperable. "If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01. The Office Action therefore fails to establish a prima facie case of obviousness with respect to claims 1-7, 9, 10, 12 and 13, and withdrawal of the rejection is respectfully requested.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Dilger et al. in view of U.S. Patent No. 4,518,181 to Yamada ("Yamada"). Applicant respectfully traverses this rejection.

Claim 8 depends on patentable claim 1 and is therefore patentable for the reasons explained above. Adding Yamada to Dilger still fails to suggest the claimed invention because Yamada only shows a transfer device pin 76 in a system that does not allow movement of an output member independently of a gear wheel. Withdrawal of the rejection is therefore respectfully requested.

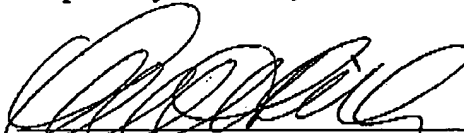
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Applicant thanks the Examiner for indicating that claim 11 would be allowable if rewritten in independent form. As explained above, however, none of the cited references disclose or suggest the invention recited in independent claim 1, from which claim 11 depends. Claim 11 is therefore allowable without further amendment.

Applicant also thanks the Examiner for indicating that claims 21-26 would be allowable if rewritten to overcome the § 112, second paragraph rejection. Applicant has rewritten independent claim 21 as noted above. Allowance of claims 21-26 is therefore respectfully requested.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited. Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,



Anna M. Shih, Reg. No. 36,372
Carlson, Gaskey & Olds
400 W. Maple Road, Ste. 350
Birmingham, MI 48009
(248) 988-8360

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I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (703) 872-9306, on May 12, 2004.


Beth A Beard